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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/771,564	01/30/2001	Akihiro Furukawa	108478	9409
25944	7590	06/30/2004	EXAMINER	
OLIFF & BERRIDGE, PLC P.O. BOX 19928 ALEXANDRIA, VA 22320			MEHRPOUR, NAGHMEH	
			ART UNIT	PAPER NUMBER
			2686	18
DATE MAILED: 06/30/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/771,564	FURUKAWA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Naghmeh Mehrpour	2686	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 06 April 2004.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 24 and 2749 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 24, 27-49 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413)
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	Paper No(s)/Mail Date: _____
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date: _____	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
	6) <input type="checkbox"/> Other: _____

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 24, 27-33, 35-45, 47-49**, are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman (US Patent Number 6,522,421 B1) in view of Stenman et al. (US Patent Number 6,223,029 B1)

Regarding claims 24, 38, 45, Chapman teaches a control method of controlling an image-forming device, comprising the steps of:

- a) receiving **image information** from an external device 11 (col 3 lines 29-35);
- b) storing the **image information** in a memory (col 3 lines 35-37); and
- c) receiving an instruction to print the **image information** (col 3 lines 33-37); and
- d) executing printing of the **image information** in accordance with the instruction (col 3 lines 60-67, col 4 lines 1-17).

Chapman fails to c) executing printing of the print data from a cellular phone. However Stenman teaches c) executing printing of the print data from a cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide

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security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 27, 39, Chapman teaches a controlling method comprising a step of :

e) outputting a signal indicating that the image information is stored in the memory (col 3 lines 33-37, col 4 lines 2-18), wherein the instruction is received from the cellular phone after the signal is output. Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). ). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 28, 35, 40, Chapman teaches a controlling method wherein the instruction is an email message transmitted in an e-mail format (col 3 lines 18-20). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). ). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 29, 41, Chapman teaches a controlling method wherein the instruction is an email message transmitted in via a Web service (col 3 lines 43-53). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 30, 36, 42, 48, Chapman teaches a controlling method wherein the image forming device has a URL (Internet address), and the instruction is transmitted to the image forming apparatus (col 3 lines 43-65). Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 31-32, 43-44, Chapman fails to teach a controlling method wherein the instruction from the cellular phone is transmitted via an audio guidance. Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction from the cellular phone is transmitted via an audio guidance (col

7 lines 52-59). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claim 33, Chapman teaches a controlling method comprising the steps of:

f) detecting an e-mail address from the image information stored in the memory (col 3 lines 33-37); and

g) sending an e-mail message to the designation of the detected e-mail address (col 3 lines 33-37), the e-mail message urging a user to transmit the instruction to the image forming device (col 3 lines 60-67, col 4 lines 1-18). Chapman fails to teach a method wherein the instruction is received from the cellular phone However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). ). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Regarding claims 47, 49, Chapman teaches a printing system method wherein the URL (Internet address) includes link to a page to instruct the printing (col 3 lines 33-56), and the instruction is sent to the image forming device by accessing the link (col 3 lines 57-67, col 4 line 1). Chapman fails to teach a method wherein the instruction is received from the cellular phone.

However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

3. **Claims 34, 46,** are rejected under 35 U.S.C. 103(a) as being unpatentable over Chapman (US Patent Number 6,522,421 B1) in view of Stenman et al. (US Patent Number 6,223,029 B1) in further view of Peyser International publication WO 94/26059.

Regarding claim 34, 46, Chapman fails to teach a method wherein the instruction is received from the cellular phone. However Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine the above teaching of Stenman with Chapman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

Chapman modified by Stenman fails to teach a method comprising the step of judging whether or not the image information is confidential information, the control unit controls the image forming unit to form images based on the image information; after the communication unit receives the predetermined code. However Peyser teaches a judging unit that judges whether or not the image information confidential information, the control unit controls the image forming unit to form images based on the image information; after the communication unit receives the predetermined code (page 6 lines 13-17, page 7 lines 21-25, page 8 lines 31-35, page 9 lines 5-

16). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine above teaching of Peyser with Chapman modified by Stenman, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

***Response to Arguments***

4. Applicant's arguments filed 4/6/04 have been fully considered but they are not persuasive.

In response to applicant's argument that Chapman fails to disclose the step executing printing of the print data from the cellular phone, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Chapman teaches print servers that involve embedding email information within an application file prior to sending it to the printer. The printer has special software to interpret this email information and the status information is then sent out to the users specified via email, and Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, Chapman modified by Stenman does teach the step executing printing of the print data from the cellular phone.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the

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teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Chapman teaches print servers that involves embedding email information within an application file prior to sending the file to a printer. The printer has special software to interpret this email information and the status and information is then sent out to the users specified via email, and Stenman teaches a method wherein the instruction is received from the cellular phone (col 7 lines 1-24, col 15 lines 20-21). Therefore, Chapman modified by Stenman does teach the step of executing printing of the print data from the cellular phone, in order to provide security to the user not only for sensitivity of the information but also the accessibility and location of the receiving equipment.

### Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

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calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

**6. Any responses to this action should be mailed to:**

Commissioner of Patents and Trademarks

Washington, D.C. 20231

**or faxed to:**

(703) 872-9314, (for formal communications indented for entry)

**Or:**

(703) 308-6306, (for informal or draft communications, please label  
“PROPOSED” or “DRAFT”)

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Va., sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Any inquiry concerning this communication or earlier communication from the examiner should be directed to Melody Mehrpour whose telephone number is (703) 308-7159. The

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examiner can normally be reached on Monday through Thursday (first week of bi-week) and Monday through Friday (second week of bi-week) from 6:30 a.m. to 5:00 p.m.

If attempt to reach the examiner are unsuccessful the examiner's supervisor, Marsha Banks-Harold be reached (703)305-4379.

NM

June 23, 2004

  
CHARLES APPIAH  
PRIMARY EXAMINER